

Appl. No. 09/721,462
Amdt. dated April 13, 2005
Reply to Office Action of 01/13/05

PATENT

REMARKS/ARGUMENTS

Claims 1-25 are pending in the application. Claims 1-25 are rejected.

REJECTIONS UNDER 35 U.S.C. § 102

Claims 1, 3, 4-6, 10, 13, 15, 16-18, 22 and 25 were rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Haertl '597(See 1/13 /05 Office Action, at page 2).

Applicants respectfully traverse this rejection. Haertl is "directed to an apparatus for closing an opening of a hearing aid or an earl adapted for a hearing aid" (Haertl, Col 1, lines 7-10; See also the Abstract) not to "an intracanal shield for positioning entirely in the ear canal and capping the cavity of said ear canal" as is recited in claim 1 or "an acoustically permeative cap shaped and dimensioned to be positioned entirely in the ear canal for extended wear therein" as is recited in claim 25.

However, in order to expedite prosecution, and without acquiescing to the propriety of the Examiner's rejection, Applicants have amended independent claims 1 and 25 to overcome the rejection. Support for this amendment is found in the Specification, claims and drawings as filed (See, e.g., the Specification at page 9, lines 8-11). Applicants expressly reserve the right to prosecute original claims 1 and 25 in continuation applications.

Amended claim 1 now recites "pores sized for allowing air to pass through said porous member to provide a circulated air flow in the ear canal sufficient to reduce an incidence of canal infection while preventing passage of fluids and solids therethrough." Amended Claim 25 recites a similar limitation. As discussed above, no where does Haertl teach or suggest an intracanal shield, let alone an intra canal shield with "pores sized for allowing air to pass through said porous member to provide a circulated air flow in the ear canal sufficient to reduce an incidence of canal infection." In fact, Haertl does not even consider the problem of canal infection, let alone the problem of canal infection due to insufficient air circulation. Clearly therefore, it can not teach a solution. Accordingly, withdrawal of the rejection is respectfully requested.

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Applicants also respectfully submit that it would be an error at law to contend that having pores sized as is recited in either or claims 1 or 25 is a property inherent in the teachings of Haertl. The courts have repeatedly held that inherency requires that skilled artisan deem a property or element to be "necessarily present" and not merely possible or even probable. See Continental Can Co. v. Monsanto Co., 948 F.2d 1264, 1268-1269 (Fed. Cir. 1991). Having pores sized as recited in claims 1 and 25 is not "necessarily present" in Haertl, because: 1) Haertl does not teach an intracanal shield but a cap for a hearing aid as discussed above; and 2) Haertl teaches that its cap is "particularly useful when embodied into a behind-the-ear hearing aid"(Haertl Col 3, lines 34-35) and; therefore, does not even require placement of its cap in the ear canal. Accordingly, for this separate and additional reason, withdrawal of the rejection is respectfully requested.

REJECTION UNDER 35 U.S.C. §103(a)

Claims 2, 4, 7, 14, 16, 17 and 19 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Haertl '597 in view of Flagler '333 (See 1/13/05 Office Action, at page 4).

Claims 12 and 14 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Haertl '597 in view of Oliveira '920 (See 1/13/05 Office Action, at page 6).

Claims 8, 9, 11, 20, 21 and 23 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Haertl '597 in view of Brown '174 (See 1/13/05 Office Action, at page 7).

Applicants respectfully traverse these rejections for reasons discussed above. However, without acquiescing to the propriety of the Examiner's rejection, applicants submit that the rejections have been overcome by the amendment to independent 1. As discussed above, Haertl '597 fails to teach or suggest all elements of amended independent claim 1. Further, none of the other cited references, alone or in combination, compensates for the deficiencies of Haertl '597 in regard to amended independent claim 1 and therefore, in regard to any dependant claim

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as well. Therefore, none of the cited references, alone or in combination, teach or suggest all elements of any of claims 2, 4, 7-9, 11, 12, 14, 16, 17, 19, 20, 21 and 23. Accordingly, withdrawal of the rejection is respectfully requested.


CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

It is believed that no fees are due with this response; however, should any fees be required under 37 C.F.R. §§ 1.16 to 1.21 for any reason, the Commissioner is authorized to charge Deposit Account No 20-1430.

Respectfully submitted,


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Attachments
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